

### REMARKS

Applicant notes that U.S. Patent No. 5,958,962 is listed on the Office's website as "Patent Expired Due to Non-Payment of Maintenance Fees Under 37 CFR 1.362." Thus, an interference is no longer requested. In view of the abandonment of U.S. Patent No. 5,958,962, Applicant has canceled claims 1-25 without prejudice to, or disclaimer of, the subject matter contained therein. Applicant maintains that the cancellation of a claim makes no admission as to its patentability and reserves the right to pursue the subject matter of the cancelled claim in this or any other patent application.

#### New Claims

Applicant has added new claims 26-31 directed to a method of decreasing cravings for sugars and carbohydrates associated with tricyclic or atypical antidepressant therapy. Support for these claims can be found at, for example, column 3, lines 19-43, and Examples 2 and 3 of the specification of U.S. Patent No. 6,034,091.

Applicant notes that 35 U.S.C. § 251 requires the Director to "reissue the patent for the invention disclosed in the original patent..." 35 U.S.C. § 251. M.P.E.P. §1412.01 provides guidance as to what constitutes "the invention disclosed in the original patent":

The reissue claims must be for the same invention as that **disclosed** as being the invention in the original patent, as required by 35 U.S.C. 251. This does *not* mean that the invention claimed in the reissue must have been claimed in the original patent, although this is evidence that applicants considered it their invention. The entire disclosure, not just the claim(s), is considered in determining what the patentee objectively intended as his or her invention. ...

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Claims presented in a reissue application are considered to satisfy the requirement of 35 U.S.C. 251 that the claims be "for the invention disclosed in the original patent" where:

(A) the claims presented in the reissue application are described in the original patent specification and enabled by the original patent specification such that 35 U.S.C. 112 first paragraph is satisfied; and

(B) nothing in the original patent specification indicates an intent not to claim the subject matter of the claims presented in the reissue application.

*M.P.E.P. §1412.01 (emphasis in original).*

Applicant submits that the newly added claims are described and enabled by the original patent specification, and nothing in the original patent specification indicates an intent not to claim the subject matter of the new claims. For example, Applicant points to the following passage from the "Summary of the Invention" of the original patent:

It has further been determined that such a drug combination using an opioid antagonist or partial antagonist decreases the craving for sugars and carbohydrates often experienced with conventional tricyclic and a-typical antidepressant therapy. *U.S. Patent No. 6,034,091* at col. 3, lines 19-24.

Thus, Applicant respectfully requests that the Examiner consider newly added claims 26-31.

#### Claim Objections and Rejections

The Examiner has raised a number of objections and rejections to the previously pending claims.

Without acquiescing to the Examiner's assertions, and solely in the interest of advancing prosecution, Applicant has canceled the previously pending claims without prejudice to, or disclaimer of, the subject matter contained therein. Applicant maintains that the cancellation of a claim makes no admission as to its patentability and reserves the right to pursue the subject matter of the cancelled claim in this or any other patent application. The objections and rejections are moot in view of the cancelation of the previously pending claims.

#### Interference

As noted above, an interference is no longer requested due to the abandonment of U.S. Patent No. 5,958,962.

#### No Disclaimers or Disavowals

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicant is not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. The Applicant reserves the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present

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disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that the Applicant has made any disclaimers or disavowals of any subject matter supported by the present application.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: \_\_\_\_\_

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By: \_\_\_\_\_

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